



TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Complete if Known

| | |
|----------------------|---------------------|
| Application No. | 09/998,661 |
| Filing Date | December 3, 2001 |
| First Named Inventor | Todd Charles MCNEEL |
| Group Art Unit | 1761 |
| Examiner Name | Robert A. Madsen |
| Attorney Docket No. | 914-1412-DV2 |
| Customer No. | 6449 |
| Confirmation No. | 7552 |

Total Number of Pages in This Submission _____

ENCLOSURES (check all that apply)

- | | | |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Assignment Papers | <input type="checkbox"/> After Allowance Communication to Group |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Drawing(s) | <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences Appellant's Substitute Brief on Appeal |
| <input type="checkbox"/> Amendment/Reply | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Terminal Disclaimer | 1. U.S. Patent No. 4,122,198 |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> Request for Refund | 2. U.S. Patent No. 4,052,838 |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> CD, Number of CD(s) | 3. U.S. Patent No. 5,298,274 |
| <input type="checkbox"/> Response to Missing Parts/Incomplete Application | | 4. U.S. Patent No. 3,520,248 |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | | |

REMARKS:

If any fees are required, the Director is authorized to charge deposit account no. 02-2135

| | | | |
|----------------------|----------------------------------|--------------------------|--|
| SUBMITTED BY | | Complete (if applicable) | |
| NAME AND REG. NUMBER | Richard Wydeven, Reg. No. 39,881 | | |
| SIGNATURE | DATE | DEPOSIT ACCT USER ID | |

914-1412.DV2.TRN2.wpd



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

App. No. : 09/998,661
Applicant : Todd Charles MCNEEL, *et al.*
Filed : December 3, 2001
TC/A.U. : 1761
Examiner : Robert A. Madsen

Docket No. : 0914-1412-DV2
Customer No. : 6449
Confirmation No. : 7552

APPELLANTS' SUBSTITUTE BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Order Returning Undocketed Appeal to Examiner dated June 3, 2005, the following comprises Appellants' Substitute Brief on Appeal from the final rejection, dated June 2, 2004, of claims 1-3¹. The original Appeal Brief filed on September 16, 2004 was accompanied by an appeal brief fee of \$330.00. The fee set forth in 37 C.F.R. § 41.20(b)(2) is \$340.00. Kindly charge the difference, or if Appellant is required to pay the entire fee, charge that fee, to deposit account no. 02-2135. Appellants' Notice of Appeal was filed on July 16, 2004. Therefore, the original Appeal Brief was timely filed.

I. REAL PARTY IN INTEREST

Recot, Inc. (now known as Frito Lay North America, Inc.), the assignee of the present application.

Adjustment date: 06/13/2005 SDENB0B1
09/17/2004 CNGUYEN 00000032 09998661
01 FC:1402 330.00 OP

06/13/2005 SDENB0B1 00000098 022135 09998661
01 FC:1402 170.00 DA 330.00 OP

¹ The order mistakenly indicates that the Appeal Brief was filed on November 15, 2004, but it was actually filed on September 16, 2004.

06/10/2005 SDENB0B1 00000148 022135 09998661
01 FC:1402 500.00 DA
Adjustment date: 06/13/2005 SDENB0B1
06/10/2005 SDENB0B1 00000148 022135 09998661
01 FC:1402 500.00 CR

II. RELATED APPEALS AND INTERFERENCES

Upon information and belief, appellants and the undersigned attorney of record is aware of no other co-pending appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-3 stand rejected under 35 U.S.C. § 103(a). Claims 1- 3 are appealed.

IV. STATUS OF AMENDMENTS

No claim amendments have been filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention will be summarized by reading the appealed claims onto the specification and drawings. See MPEP §1206, at 1200-10.

The invention of independent claim 1 relates to a method of making triangular tortilla chips in a manner which facilitates subsequent packaging of the chips in a stacked arrangement. The method includes the step of cutting triangular tortilla chip preforms (ref. no. 121, Fig. 2) from a sheet of masa. (Page 10, Ins. 24-27, ¶42). The tortilla chip preforms are then placed in molds (ref. nos. 26, 28, Figs. 2, 3, 5) with a consistent orientation which comprises an alternating pattern of chip preforms with base edges (ref. no. B, Fig. 2) and apex corners (ref. no. A, Fig. 2) of successive tortilla chip preforms arranged in alternating orientations (i.e., the apex corner (A) of one preform (121) points in one direction and the apex corners (A) of the preceding and following preforms (121) point in an opposite direction). (Page 10, Ins 27-28, ¶42, Fig. 2). The chip preforms (121) within the molds (26, 28) are thereafter cooked in a cooking medium (e.g. in oil pan 30, see Fig. 1) while the chip preforms are restrained within the molds, thereby substantially maintaining the orientation of the tortilla chip preforms while they are being cooked. (Page 11, Ins 3-16, ¶44, Figs. 2, 3, 5). The cooked

tortilla chips are thereafter removed from the molds while substantially maintaining the preferred orientation of the preforms. (Page 11, Ins 23-29, ¶46, Fig. 8).

According to another aspect of the invention as recited in dependent claim 2, the cooked tortilla chips (ref. no. 221, Fig. 12A) are packaged in a generally triangular canister (ref: no. 321, Fig. 12A). (Page 12, lines 25-28, ¶ 49, Fig. 12A)

According to another aspect of the invention as recited in dependent claim 3, the sheet of masa is formed by forming a sheet of snack food dough, toasting the sheet of dough to achieve a desired moisture content, and proofing the sheet of dough to cause the moisture to equilibrate. (pages 9-10, ¶¶ 40-41). A desired texture is imparted to the sheet by passing the sheet through a shaping rollers (ref. no. 200, Fig. 9). (pages 11-12, ¶47, Fig. 9)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-3 are unpatentable under 35 U.S.C. § 103(a) as obvious over Wisdom et al. (U.S. 4,122,198) in view of Hilton et al. (U.S. 4,052,838) and Khalsa (U.S. 5,298,274) and MacKendrick (U.S. 3,520,248) (See Evidence Appendix).

VII. ARGUMENT

Rejection Under 35 U.S.C. § 103(a)

Claims 1 - 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wisdom et al. (US 4,122,198) in view of Hilton et al. (US 4,052,838), and Khalsa (US 5,298,274), and MacKendrick (US 3,520,248). Applicants respectfully request that the rejection of claims 1-3 be reversed for the following reasons.

To establish a *prima facie* case of obviousness, (1) there must be some suggestion or motivation to modify a reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference(s) must teach or suggest all the claim limitations. MPEP §2143. The rejection of claims 1 - 3 as being unpatentable over Wisdom in view of Hilton and Khalsa and MacKendrick is improper because: (A) the references do not teach or suggest all the claim limitations; and (B) there is no suggestion or motivation

cited in the Office Action for combining the teachings of these references to derive the specific combination recited in the claims.

Independent claim 1 is directed to a method of making a stackable triangular tortilla chip. The method includes the steps of "cutting triangular tortilla chip preforms...; enclosing the tortilla chip preforms in molds with a consistent orientation; restraining the tortilla chip preforms within said molds while cooking the tortilla chip preforms in a cooking medium...; and then removing cooked tortilla chips from said molds while substantially maintaining the orientation of the tortilla chip preforms; wherein said consistent orientation comprises an alternating pattern of tortilla chip preforms with base edges and apex corners of successive tortilla chip preforms within the molds alternating orientation...." (See Claims Appendix)

The cited references do not disclose the step of restraining triangular tortilla chip preforms while arranged in alternating orientations within molds while cooking the preforms or removing the cooked chips while keeping the chips arranged in alternating orientations.

Wisdom describes that the preferred products are chip-type products which conform to the shape of a mold and are of a uniform size and shape so as to be capable of being stacked. (Col. 2, Ins. 52-55). There is no disclosure or suggestion of cutting chips in a triangular shape, orienting them in an alternating manner, restraining them in the alternating orientations within a mold while being fried, and removing them in the alternating orientations.

Hilton describes that uniformly-shaped chips can be physically restrained in a mold while being fried. (Col. 1, Ins. 24-26). There is no disclosure or suggestion of forming chips in a triangular shape, orienting them in an alternating manner, restraining them in a mold while oriented in the alternating manner, and removing them in the alternating orientations.

Khalsa describes an apparatus for forming triangular tortilla chip preforms arranged in an alternating orientation. (Figure 2, col. 5, Ins. 32-47). Khalsa does not describe or suggest restraining the triangular, alternately - oriented chips in molds while being fried or thereafter removing the cooked chips from the molds while maintaining the alternate orientation arrangement.

Finally, MacKendrick describes a method whereby oval-shaped chip preforms are cut and then restrained between saddle-shape mold elements during frying. (Figures 7, 8, col. 6,

Ins. 13-47). There is no description or suggestion of forming triangular-shaped preforms arranged in alternating orientations, restraining the preforms within a mold while arranged in the alternating orientations, and removing the cooked chips from the restraining molds while maintaining the alternate orientation arrangement.

Accordingly, none of the cited references teaches or suggests the steps of "enclosing the [triangular] tortilla chip preforms in molds with a consistent orientation; restraining the tortilla chip preforms within said molds while cooking the tortilla chip preforms in a cooking medium, thereby substantially maintaining the orientation of the tortilla chip preforms while they are being cooked; and then removing cooked tortilla chips from said molds while substantially maintaining the orientation of the tortilla chip preforms; wherein said consistent orientation comprises an alternating pattern of tortilla chip preforms with base edges and apex corners of successive tortilla chip preforms within the molds alternating orientation"

Moreover the suggestion that the combined steps of enclosing, restraining, cooking, and then removing triangular chips while maintaining the pattern of alternating orientations would have been obvious from the asserted combination of references is improperly based in hindsight on applicants' disclosure as there is no motivation or suggestion to modify and or combine the references in the manner asserted.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also MPEP § 2143.01. Virtually all inventions are combinations of old elements. See In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at 1457. If identification of each claimed element in the prior art were sufficient to negate patentability, the Examiner could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. See Id. Thus, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). "Even when obviousness is based on a single reference,

there must be a showing of a suggestion or motivation to modify the teachings of that reference.” In re Kotzab, 217 F.3d at 1370, 55 USPQ2d at 1316-1317.

While the Examiner attempts to set forth a motivation for modifying the teachings of the primary reference, Wisdom, and combining the teachings of Wisdom, Hilton, Khalsa, and MacKendrick, the suggested motivation fails to explain how one of ordinary skill would have been motivated to derive the claimed invention. That is, the suggested motivation does not explain “the desirability of making the specific combination that was made by the [applicants].” Id.

It is admitted in the Office Action that Wisdom, the primary reference, fails to teach triangular chip preforms or holding such preforms in molds during frying or baking such that the base edges and apex corners of successive chips are arranged in alternating orientations in the mold. Office Action of 06/02/04, at p. 3, ¶7. Wisdom, also lacks teaching of removing the cooked chips while keeping them arranged in alternating orientations.

Hilton is cited for its disclosure that uniformly-shaped chips can be physically restrained in a mold while being fried to yield uniform, stackable chips. Id., at p. 3, ¶8. The Examiner further asserts that one of ordinary skill would have recognized that uniform chips would facilitate subsequent packaging in a stacked arrangement and thus Hilton provides motivation for modifying the frying step of Wisdom to provide uniform chips and thereby facilitate subsequent stacking. Id.

MacKendrick, like Hilton, is cited for its disclosure of “a method of frying chips in molds to provide uniformly shaped chips.” Id. at p. 4, ¶ 10. And, as with Hilton, it is suggested that one of ordinary skill would have recognized that uniform chips would facilitate subsequent packaging in a stacked arrangement and thus MacKendrick provides motivation for modifying the frying step of Wisdom to provide uniform chips and thereby facilitate subsequent stacking. Id.

None of Wisdom, Hilton, or MacKendrick, however, teaches triangular chips, arranging triangular chips in alternating orientations, and restraining, cooking, and thereafter removing the triangular chips while keeping them arranged in the alternating orientations. And the Examiner fails to explain how the teachings of Wisdom, Hilton, and/or MacKendrick would motivate a

person of ordinary skill to perform the claimed steps of enclosing, restraining, cooking, and then removing triangular chips while maintaining the pattern of alternating orientations, as recited in claim 1.

Khalsa is cited in the Office Action as alleged "evidence of the conventionality of producing fried tortilla chips in a triangular shape." Office Action of 06/02/04, at p. 4, ¶ 9. And the Examiner further asserts that selecting such an allegedly conventional shape "would have been an obvious matter of design choice." *Id.* Applicants strongly disagree.

Applicants' invention involves much more than merely substituting one known chip shape for another. Prior to applicants' invention, triangular was not a conventional shape for stackable chips; conventional stackable chips had oval, saddle shapes. Moreover, applicants devised a methodology in which stackable triangular chips are formed while keeping the chips arranged in alternating orientations throughout the cutting, cooking, and removing processes. This maximizes the efficiency of, and reduces the waste involved in, the chip forming process.

The cited art does teach or suggest such a methodology. The alleged fact that Khalsa establishes that triangular is a conventional shape for stackable chips, even if true, or the fact that Wisdom, Hilton, and MacKendrick teach that uniform chips facilitate subsequent packaging in a stacked arrangement, does not explain how or why one of ordinary skill would have been motivated to arrange the chips in alternating orientations and then maintain them in that arrangement throughout the restraining, cooking, and removing steps. Thus, the motivation suggested by the Examiner does not address the specific combination that was made by the applicants.

Without any motivation for combining the references and modifying the process described in Wisdom based on the teachings of the secondary references to derive the claimed invention, the proposed combination/modification is no more than a hindsight reconstruction of the claimed invention. Thus, the Office Action fails to make out a *prima facie* case of obviousness. For these reasons, the rejection of independent claim 1 is improper and applicants respectfully request that it be reversed.

Appellants' Substitute Brief on Appeal
under 37 C.F.R. § 41.37
Serial Appln. No. 09/998,661
Filed June 9, 2005

Dependent claims 2-3 are allowable as depending from allowable claim 1.

Respectfully submitted,

By



Richard Wydeven
Attorney for Applicants
Registration No. 39,881
ROTHWELL, FIGG, ERNST & MANBECK, p.c.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202)783-6040

Date: June 9, 2005

Attachment: CLAIMS APPENDIX
EVIDENCE APPENDIX
RELATED PROCEEDINGS APPENDIX

CLAIMS APPENDIX

1. (Originally presented) A method of making triangular tortilla chips in a manner which facilitates subsequent packaging in a stacked arrangement, said method comprising:

cutting triangular tortilla chip preforms from a sheet of masa;
enclosing the tortilla chip preforms in molds with a consistent orientation;
restraining the tortilla chip preforms within said molds while cooking the tortilla chip preforms in a cooking medium, thereby substantially maintaining the orientation of the tortilla chip preforms while they are being cooked; and then
removing cooked tortilla chips from said molds while substantially maintaining the orientation of the tortilla chip preforms;

wherein said consistent orientation comprises an alternating pattern of tortilla chip preforms with base edges and apex corners of successive tortilla chip preforms within the molds alternating orientation, whereby said tortilla chip preforms can be placed relatively compactly and close together within said molds so as to minimize space therebetween.

2. (Originally presented) The method of claim 1, further comprising packaging said cooked tortilla chips in a generally triangular canister.

3. (Originally presented) The method of claim 1, wherein said sheet of masa is formed by:

forming a sheet of snack food dough;
toasting the sheet of snack food dough to achieve a desired moisture content;
proofing the sheet of snack food dough such that the moisture content thereof equilibrates; and

imparting a desired texture to said sheet of snack food dough by passing said sheet of snack food dough through a shaping roller assembly.

EVIDENCE APPENDIX

The following items are attached:

- (1) Evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132:

No such evidence is relied upon by appellant in the appeal.

- (2) Evidence entered by the Examiner:

No such evidence is relied upon by appellant in the appeal.

- (3) Evidence relied upon by the Examiner as to grounds of rejection to be reviewed on appeal.

(a) U.S. Patent No. 4,122,198 (cited in Office Action of November 6, 2003, at page 2)

(b) U.S. Patent No. 4,052,838 (cited in Office Action of November 6, 2003, at page 2)

(c) U.S. Patent No. 5,298,274 (cited in Office Action of November 6, 2003, at page 2)

(d) U.S. Patent No. 3,520,248 (cited in Office Action of November 6, 2003, at page 2)

Appellants' Substitute Brief on Appeal
under 37 C.F.R. § 41.37
Serial Appln. No. 09/998,661
Filed June 9, 2005

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.